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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,978	06/22/2001	William Gray	1780/1D144-US2	9044
7590 06/10/2004			EXAMINER	
DARBY & DARBY P.C. 805 Third Avenue New York, NY 10022			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/887,978	Applicant(s) GRAY ET AL.
	Examiner Michael Thaler	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22 and 23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3731

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 26, 2004 has been entered.

This application contains claims 24-32 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Mazzocchi (WO 96/01591). Mazzocchi, in figures 11A and 11B, shows catheter (e.g., the balloon catheter described on page 29, lines 6-13), guide wire 260 and collapsible filter 270.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzocchi (WO 96/01591). Mazzocchi, in figures 11A and 11B, shows tubular shaft 274, core wire 260 and collapsible filter 270. Mazzocchi fails to specifically

indicate that tubular shaft 274 is flexible as claimed. However, Mazzocchi indicates that the shaft 274 may be formed of a thin walled hypotube (page 29, lines 28-31) which obviously is flexible since thin walled hypotubes are typically flexible due to the thinness of their walls.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzocchi (WO 96/01591) in view of Gunther et al. (5,329,942). Assuming *arguendo* that tubular shaft 274 of Mazzocchi is not flexible, it is noted that the mechanism to expand and collapse the Mazzocchi filter is complicated and includes numerous tethers 290. Gunther et al. teach that a collapsible vascular filter may be expanded and collapsed by the simple relative slidable displacement between a core wire 15 and flexible shaft 19 (col. 5, lines 37-47). Including a similar core wire and flexible shaft with the Mazzocchi filter in order to provide a simpler mechanism to expand and collapse it would have been obvious.

Applicant's arguments filed Feb. 10, 2003 have been fully considered but they are not persuasive. The allegation that the Mazzocchi guidewire does not direct a balloon catheter is simply unfounded. Mazzocchi teaches that the balloon catheter can track the guidewire (page 39, line 30-32) which directs the

balloon catheter to the desired location within the vasculature. The allegation that the Mazzocchi filter is not "for manual deployment" as defined in claim 22 is also simply unfounded. Mazzocchi teaches that the filter is manually pushed distally beyond the end of the introduction catheter to deploy it (page 39, line 25-30). As to claim 23, although the Gunther et al. filter is disclosed as being used as a vena cava filter, it is broadly a filter used in the patient's vasculature and is therefore similar to the Mazzocchi filter.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS


of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
6/8/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731